<u>PATENT</u>

<u>REMARKS/ARGUMENTS</u>

Claims 1-20 were pending. Claims 1-20 were rejected as obvious under 35 USC 103(a) by Bergsman et al. U.S. Pat. No. 5,146,487 (Bergsman) in view of Kugell et al. U.S. Pat. No. 5,751,794.

In light of the following remarks, the undersigned respectfully requests withdrawal of the objections of the pending claims.

I.   The present invention

The present invention relates to systems and methods for allowing voice mail users to make outbound calls while connected to a voice mail system. In the embodiments described, these outbound calls are traditional voice calls, see p. 11, lines 14-28.

As previously discussed, if the Examiner has ever checked voice mail messages remotely, the Examiner should understand the inconvenience of making a call to a voice mail system, having to hang up, and to separately make a return call. If there are multiple messages and multiple people to call back, it would require multiple separate phone calls.

Embodiments of the present invention allow the user to make telephone calls <u>without disconnecting the caller to the voice mail system</u>. For example, as illustrated in Fig. 3A, while in a state in the voice mail server, the voice mail server provides a menu of selections, and prompts the caller for instructions, step 370. The menu of selections can include standard voice mail functions, and the call out function. P. 9, lines 27 - p. 10, line 21. Based upon the caller input, step 380-390, in some cases, the caller input are voice mail functions, step 400. Further, in some cases, the selection is the call out function, steps 410-470.

In the present embodiments, the telephone call is made without disconnecting the caller to the voice mail system. Steps 410 and 470 describe saving the state of the voice mail system, before making the outbound call and returning to the same voice mail state, after the outbound call has completed.

As previously discussed, embodiments of the present invention allow the calls made by the caller in steps 420-460 to be made <u>in "real-time."</u> That is, these phone calls are typically calls that allow the caller and the called party to communicate in real-time.

Claim 8 recites code configured to direct the processor to process the telephone number in real-time to make the outbound call from the caller to the receiver; and code configured to direct the processor to restore the session of the caller within voice mail server after the outbound call is terminated.

In addition, Claim 1, as amended, also recites providing a menu of voice mail services to the caller, wherein the menu includes a menu selection to initiate review of incoming voice mail messages, and a menu selection to initiate an outbound call; and receiving a request from the caller of the menu selection to initiate an outbound call.

In addition, Claim 14, as amended, also recites code that directs the processor to determine when the telephone call to the receiver is finished and code that directs the processor to return to the state location of the caller within the voice mail server when the telephone call to the receiver is finished.

II.   The cited references

A.   Bergsman

As previously described, Bergsman describes a system for sending recorded telephone greetings to a recipient. These messages are scheduled for delivery at a scheduled time, and are not in real-time, as the Examiner agrees.

Bergsman only appears to describe a specialized system that allows a caller to schedule the telephone greetings. The calls are not in real-time and Bergsman does not describe a generalized voice mail system having conventional voice-mail capability.

B.   Kugell

Kugell appears to describe a message delivery server that can avoid making recursive telephone calls. As illustrated in Fig. 1, a caller calls a customer, 101. If the customer is busy, 102, the call is sent to the message delivery server, 104. Since the initiator of the call is a caller, 105, the message delivery server records the caller's message, 107.

Next, "[i]n accordance to a retry schedule at 109, the [message delivery] server attempts delivery of the stored message at 108 to the customer." Col. 4, lines 43-45. In this iteration, if the customer is still busy, 102, the call is sent to the message delivery server, 104.

However, since the initiator of the call is now the message delivery server, not the caller, 105, the call is dropped, 106, avoiding a recursive loop.

Importantly, Kugell does not describe anything about making calls in real-time. Instead Kugell describes a retry schedule 109 and 303, and waiting" a predetermined amount of time" before repeating the request, col. 5, lines 3-8-10.

Further, Kugell does not describe the message delivery server as a generalized voice mail system having conventional voice-mail capability. Accordingly, Kugell does not need to store the state of the system before sending the message. Further, because Kugell's message delivery is not made in real-time, Kugell does not disclose any need for detecting when the outbound call is complete, before restoring the state of the system after the messages are delivered.

III. The cited art distinguished

A. Claim 8

The limitations of Claim 1 are not made obvious by Bergsman in light of Kugell.

Claim 8 recites code configured to direct the processor to process the telephone number in real-time to make the outbound call from the caller to the receiver; and code configured to direct the processor to restore the session of the caller within voice mail server after the outbound call is terminated.

The undersigned agrees with the Examiner that Bergsman does not disclose making an outbound call from the caller to a receiver in real-time nor restoring the state of the voice mail server, as recited above.

However, the undersigned respectfully traverses the Examiner's assertion that Kugell teaches these limitations. As discussed above, Kugell also describes a message delivery system that does not make calls in real-time from caller and the receiver, but makes repeated calls to the receiver according to repeat schedules. Specifically, Kugell describes:"[i]n accordance to a retry schedule at 109, the [message delivery] server attempts delivery of the stored message at 108 to the customer." Col. 4, lines 43-45. Therefore, Kugell does not teach making calls in real-time from the caller and the receiver.

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Additionally, the message delivery system of Kugell is not a voice mail system, and it is not interrupted when it attempts to deliver messages. Accordingly, unlike the claimed limitations, there is no need in Kugell to store and restore a caller's session, as recited above.

The undersigned traverses the Examiner's assertion that one would be motivated to combine the cited references for "important or urgent subject matter." Even if Bergsman or Kugell could be combined, the combination would be as discrete parts of a message infrastructure: Bergsman would primarily provide message recording capability, and Kugell would primarily provide the mechanism for delivering recorded messages. The combination would not provide any specific benefits more than what the separate references disclosed. There is no notion of urgency in Kugell. As discussed above, Kugell describes delivering messages on a schedule, and not in real-time.

Accordingly, because neither Bergsman or Kugell disclose all the limitations of claim 8, no prima facie case of obviousness can be maintained.

B.   Claim 1

The limitations of Claim 1 are not made obvious by Bergsman in light of Kugell.

In addition to the above discussion, Claim 1, also recites <u>providing a menu of voice mail services to the caller</u>, wherein the menu includes <u>a menu selection to initiate review of incoming voice mail messages, and a menu selection to initiate an outbound call</u>; and <u>receiving a request from the caller of the menu selection to initiate an outbound call</u>.

As discussed above, because Bergsman and Kugell merely describe specialized servers to provide telephone greetings or recorded messages to callers, such servers do not provide voice mail functionality as recited above. In contrast, claim 1 recites providing a voice mail menu selection such as reviewing voice mail messages, and processing a menu selection to make outbound calls, as recited above.

Accordingly, because neither Bergsman or Kugell disclose all the limitations of claim 1, no prima facie case of obviousness can be maintained.

C.   Claim 7

The limitations of Claim 7 are not made obvious by Bergsman in light of Kugell

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In addition to the above discussion, Claim 7, also recites <u>providing a dial tone to</u> <u>the caller in response to the request</u>.

Neither Bergsman or Kugell disclose this limitation, accordingly, no prima facie case of obviousness can be maintained.

D.   Claim 14

The limitations of Claim 14 are not made obvious by Bergsman in light of Kugell.

In addition to the above discussion, Claim 14, as amended, also recites <u>code that</u> <u>directs the processor to determine when the telephone call to the receiver is finished and</u> code that directs the processor to return to the state location of the caller within the voice mail server when the telephone call <u>to the receiver</u> is finished.

As discussed above, because Bergsman and Kugell merely describe specialized servers to provide telephone greetings or recorded messages to callers, such servers do not provide voice mail functionality. Accordingly, neither Bergsman or Kugell disclose determining whether the telephone call is finished prior to returning the state of the voice mail server, as described above.

Accordingly, because neither Bergsman or Kugell disclose all the limitations of claim 14, no prima facie case of obviousness can be maintained.

E.   Remaining Claims

Claims 9-13, dependent upon claim 8 are also not obvious in light of Bergsman in view of Kugell, for at least the same reasons as claim 8 and more particularly, for the specific limitations they recite.

Claims 2-7, dependent upon claim 1 are also not obvious in light of Bergsman in view of Kugell, for at least the same reasons as claims 1 or 8 and more particularly, for the specific limitations they recite.

Claims 15-20, dependent upon claim 14 are also not obvious in light of Bergsman in view of Kugell, for at least the same reasons as claims 1, 8, or 14, and more particularly, for the specific limitations they recite.
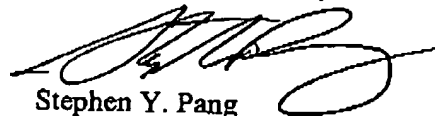
Claim 20, dependent upon claim 14 is also not obvious in light of Bergsman in view of Kugell for at least the same reasons as claim 7, and more particularly, for the specific limitations it recites.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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